

REMARKS

Claims 1-47 are pending in the application. Reconsideration is respectfully requested in light of the following remarks.

Rejections:

The Examiner rejected claims 1, 2, 5, 6 and 9-16 under 35 U.S.C. § 102(a) as being anticipated by Adams (U.S. Patent 6,718,470). Applicants respectfully traverse this rejection for at least the following reasons.

Regarding claim 1, Adams fails to disclose a client receiving a capability credential that indicates that the client has the right to use only a portion of a service's capabilities, wherein the portion is less than a total of the capabilities provided by the first service. Adams teaches a system for granting security privileges by providing test criteria data so that security privilege certificates (or other authorization credentials) may be selected from among multiple subscriber privilege data. Adams teaches that certificates, such as Kerberos tickets, privilege attribute certificates, or other public key certificates (Adams, column 7, lines 48-55) may be selected from among multiple privilege data based on test criteria supplied by a relying unit (such as a software application, computer node or other entity). A selector entity may search a common repository of security privilege certificates. The selector entity then returns *any and all privilege data that meets the test criteria data*. Thus, the selector unit may return multiple certificates, each of which meets the test criteria data. *See*, Adams, column 3, lines 26-59; column 4, lines 25-36; and column 5, lines 18-46. **Adams does not mention anything about a selecting and returning a certificate that indicates a subscriber unit (client) has the right to use only an indicated portion of a service's capabilities.** Instead, Adams states that any matching attribute certificates are sent as privilege data (Adams, column 6, lines 65-67). The certificates in Adams do not indicate that a client has the right to use *only* a portion that is less than all of a service's provided capabilities.

No mention is made in Adams of allowing access to only a portion of a service's capabilities.

The Examiner cites column 5, lines 14-32 of Adams and refers to Adams' teachings regarding a subscriber communicating a request for another application controlled by a relying party and regarding a certificate selector analyzing a subscriber's attribute certificates to determine whether any of them contain privilege data that is consistent with privilege test criteria. **However, the teachings of Adams relied on by the Examiner do not disclose a client receiving a capability credential that indicates that the client has the right to use *only a portion* of a service's capabilities, wherein the portion is less than a total of the capabilities provided by the first service.** Instead, the Examiner's cited passage describes a particular manner in which Adams' system determines whether the subscriber certificates, such as data representing a subscriber unit's privilege status, meets the particular required privilege test criteria data. Adams teaches that privilege test criteria data indicates "the specific privilege information necessary for the relying party to grant privilege to a subscriber unit" (Adams, column 3, lines 47-51). Thus, the portions of Adams relied on by the Examiner are not referring to a capability credential indicating that a client has the right to use only a portion of a services capabilities. Instead, the cited portions of Adams are teaching a particular method of determining whether a subscriber's privilege status meets the particular privilege requirements of a relying unit. As noted above, the certificates in Adams do not indicate that a client has the right to use *only* a portion of a service's capabilities. In fact, Adams makes no mention regarding allowing access to only a portion of a service's capabilities.

Applicants remind the Examiner that anticipation requires the presence in a single prior art reference disclosure of each and every limitation of the claimed invention, arranged as in the claim. M.P.E.P 2131; *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). The identical invention must be shown in as complete detail as is contained in the claims. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). As discussed above, Adams **clearly** fails to

disclose a client receiving a capability credential that indicates that the client has the right to use only a portion of a service's capabilities, wherein the portion is less than a total of the capabilities provided by the first service. Therefore, Adams clearly cannot be said to anticipate claim 1.

Thus, for at least the reasons above, the rejection of claim 1 is not supported by the cited art and removal thereof is respectfully requested. Similar remarks apply to the § 102 rejections of claims 17 and 33 as well.

Regarding claim 5, Adams fails to disclose the client receiving an advertisement for the first service, wherein the advertisement describes the portion of the first service's capabilities. The Examiner admits that Adams makes "no specific mention of the advertisement" but asserts, "advertisement serves as a way of letting the user be aware of the service[s] available." The Examiner has clearly failed to provide a proper rejection of claim 5. By admitting that Adams does not disclose the use of an advertisement, the Examiner has clearly admitted that Adams fails to anticipate claim 5. The Examiner's statement regarding how advertisements may serve as a way of letting a user know what services are available has absolutely no bearing on the fact that Adams fails to disclose anything about an advertisement for a service that describes a portion of the service's capabilities. The fact that Adam's system might benefit from the use of such an advertisement, as suggested by the Examiner, is irrelevant to a rejection based on anticipation (i.e. § 102). The Examiner's statement is also unsupported by any evidence of record.

As the Examiner is surely aware, a claim is "anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" (M.P.E.P. § 2131). As admitted by the Examiner, Adams fails to disclose the use of an advertisement. Moreover, the Examiner has not shown that the use of advertisements is inherent in Adams' system. "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence" and "[s]uch evidence must make clear

that the missing descriptive matter is *necessarily present* in the thing described in the reference” (emphasis added, M.P.E.P. § 2131.01 III). As noted above and admitted by the Examiner, Adams makes no mention of advertisements, nor has the Examiner provided any evidence showing that advertisements are *necessarily present* in Adams’ system. Instead, the Examiner has merely concluded that the use of an advertisement might be beneficial, which as stated above, is completely speculative and irrelevant. The Examiner is merely using hindsight speculation, which is clearly improper.

In the Response to Arguments, the Examiner asserts that a subscriber request to access an application through Adams’ relying party’s website “indicates that the advertisement for certain services exist as to enable a subscriber to request privilege to use such service”, citing column 5, lines 14 – 18 of Adams. The Examiner further asserts, “Adams inherently disclose[s] these limitation[s] as they are [an] essential requirement for a subscriber to request certain services provided by a relying party.” Thus, the Examiner’s argument is that the mere fact that a subscriber unit makes requests the use of a service inherently discloses the specific limitations of claim 5. The Examiner is incorrect.

The Examiner’s cited portion of Adams (column 5, lines 14 –18) merely states that a subscriber unit may communicate a request over a global network link to a website of a relying party request access to another application controlled by the relying party to facilitate a financial transfer. The cited passage does not contain any teaching that may be considered to inherently include a client receiving an advertisement for a service that describes a portion of the service’s capabilities. In fact, Adams does not describe anything about a client receiving any sort of information that describes a portion of a service’s capabilities. Nor has the Examiner provided any explanation or interpretation of Adams that includes the subscriber unit, which the Examiner equates to the client of Applicants’ claim, receiving any such information. Instead, the Examiner merely asserts that Adams’ teachings inherently disclose the specific limitations of Applicant’s claims.

As noted in the M.P.E.P. at 2131.01 III, “[t]o serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence.” However, “[s]uch evidence *must* make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference and that it would be so recognized by persons of ordinary skill” (italics added). The Examiner has not provided any extrinsic evidence that Adams’ system necessarily includes a client receiving an advertisement for a service that describes a portion of the service’s capabilities. Moreover, M.P.E.P. 2112 IV states, “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic” (underlining in original). The Examiner’s opinions that Adams’ system inherently includes the use of advertisements “as a way of letting the user be away of the service available” or “to enable a subscriber to request privilege to use such service” are not extrinsic evidence that makes clear that the use of advertisements as recite in Applicants’ claim 5 is necessarily present in Adams’ system.

Additionally, Adams fails to disclose that a client’s indication of the set of desired capabilities comprises an indication of the advertisement. As noted above, Adams fails to mention anything about advertisements, as admitted by the Examiner. Furthermore, Adams does not mention anything about a client indicating a set of desired capabilities as part of requesting a capability credential, *where the indication of the set of desired capabilities includes an indication of an advertisement for a service*. As noted above, the Examiner has merely stated that the use of advertisements would be beneficial to Adams’ system without showing that Adams’ system actually includes the use of advertisements. The Examiner has not provided any argument, explanation, or evidence showing that Adams’ system includes a client indicating a set of desired capabilities, where that indication includes an indication of an advertisement for a service providing those capabilities.

The Examiner cites column 6, lines 31-67 of Adams and states, “the subscriber wants to access the relying party’s service, but has to request [a] credential from the

centralized privilege data selector by submitting the subscriber's identity and the relying party's identifier." Thus, the cited passage only mentions that a subscriber includes an identification of the relying party, but makes no mention of any indication of an advertisement that describes a portion of the first service's capabilities. Furthermore, the cited passage only teaches that Adams' subscriber unit includes the relying party's identifier when requesting a security certificate. The cited passage makes no mention of the client including an indication of an advertisement for a service as part of an indication of a set of desired capabilities, as required by Applicants' claim 5. Nor does the Examiner mention anything about Adams' subscriber including an indication of an advertisement for the service when indicating a set of desired capabilities.

Thus, for at least the reasons above, the rejection of claim 5 is not supported by the cited art and removal thereof is respectfully requested. Similar remarks also apply to claims 21 and 37.

Regarding claim 6, contrary to the Examiner's assertion, Adams fails to disclose where the indication of the advertisement is the advertisement itself. The Examiner cites column 5, lines 14-18. However, the cited portion of Adams makes no mention of any indication of an advertisement, nor that such an indication of an advertisement is the advertisement itself. Instead, the cited passage states that a subscriber unit may communicate a request over a global network link to a website of a relying party requesting access to another application controlled by the relying party to facilitate a financial transfer. The cited passage provides no support for the Examiner's rejection of claim 6. Furthermore, in the rejection of claim 5, the Examiner admits that Adams makes no mention of advertisements.

In the Response to Arguments, the Examiner asserts that the use of advertisements is inherent in Adams' system. The Examiner is incorrect. Please refer to the remarks above regarding claim 5 for a detailed discussion regarding the fact that Adams' system does not inherently disclose the limitations of Applicants' claims.

Furthermore, the Examiner have failed to provide an explanation or interpretation of Adams in which a subscriber unit's request necessarily indicates a set of desired capabilities that includes an indication of an advertisement (as recited in claim 5) where the indication of the advertisement is the advertisement itself, as recited in claim 6. Following the Examiner's line of reasoning (that the use of advertisements are inherent in Adams' system) a subscriber's request would also have to inherently include an advertisement. There is nothing about Adams' system that inherently requires a subscriber unit to include an advertisement (of which Adams makes no mention) in an indication of capabilities as part of requesting a capability credential. The Examiner's interpretation is clearly incorrect.

The Examiner has clearly failed to make a proper rejection of claim 6. The rejection of claim 6 is not supported by the cited art and removal thereof is respectfully requested. Similar remarks also apply to claims 22 and 38.

Regarding claim 9, Adams does not disclose an advertisement that is a protected advertisement that describes the first service's capabilities but does not provide an interface to the first service's capabilities. The Examiner cites column 5, lines 14-18 where Adams teaches that a subscriber unit may send a request message to a website of a relying party to request access to another application controlled by the relying party to facilitate a financial transfer. As noted above regarding the rejection of claim 6, the cited passage makes no mention of any advertisements of any kind.

The Examiner argues, "the website describes the service, and the service can be provided upon authentication." However, the Examiner is clearly speculating regarding the workings of Adams' system. Adams does not mention that the website describes any service provided by the relying party. The Examiner's speculation regarding the website is improper and irrelevant in a rejection based on anticipation. Additionally, the Examiner is ignoring the specific limitations (in claim 5, from which claim 9 depends) regarding the client *receiving the advertisement* for the service and regarding where the

client's indication of a set of desired capabilities *includes an indication of the advertisement*. The cited passage only mentions that a subscribing unit may send a request to a website. Adams does not mention anything about the subscribing unit including an indication of any website in an indication of a set of desired capabilities, as would be required according to the Examiner's rejection of claim 9.

In the Response to Arguments, the Examiner asserts (erroneously) that use of advertisements is inherent in Adams' system. The Examiner fails to provide any argument, evidence or interpretation of Adams that includes a protected advertisement describing a service's capabilities, but not providing an interface to the service's capabilities. As described above regarding claim 5, the Examiner's line of reasoning is that since Adams' system including a subscriber unit sending a request to access a service inherently includes the specific limitations of Applicants' claims. However, there is nothing about Adams' system that requires a protected advertisement describing a service's capabilities, but not providing an interface to the service's capabilities. The Examiner's interpretation is clearly incorrect.

Thus, the rejection of claim 9 is not supported by the cited art and removal thereof is respectfully requested. Similar remarks also apply to claims 25 and 41.

Applicants also assert that numerous other ones of the dependent claims recite further distinctions over the cited art. However, since the rejection has been shown to be unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time.

The Examiner rejected claims 3 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Adams, claim 4 as being unpatentable over Adams in view of Czerwinski, et al. ("An Architecture for Secure Service Discovery Service") (hereinafter "Czerwinski"), claims 17-23, 25-39 and 41-47. Claims 17-23, 25-39 and 41-47 were rejected under 35 U.S.C. § 102(a) as being clearly anticipated by Adams or under 35

U.S.C. § 103(a) as being unpatentable over Adams in view of Czerwinski. Applicants respectfully traverse these rejections for at least the reasons presented above regarding their respective independent claims and additionally for the reasons below.

Regarding the § 102(a) rejection of claims 17 and 33, as noted above regarding the § 102 rejection of claim 1, Adams fails to disclose a client receiving a capability credential that indicates that the client has the right to use only a portion of a service's capabilities, wherein the portion is less than a total of the capabilities provided by the first service. Please refer to the remarks above regarding the rejection of claim 1 for a more detailed explanation regarding why Adams fails to anticipate claim 1, which apply with equal force the § 102 rejection of claims 17 and 33.

Regarding the alternative § 103(a) rejection of claims 17 and 33, the Examiner has failed to provide a proper rejection. The Examiner states, “claims 17-23, 25-39, and 41-47 encompass the same scope as claims 1-7 and 9-16” and that “claims 17-23, 25-39, and 41-47 are rejected based on the same reasons set forth in rejecting claims 1-7 and 9-16.” However, claims 1-7 and 9-16 are not rejected under § 103(a) as being unpatentable over Adams in view of Czerwinski. Thus, the Examiner has failed to provide a proper § 103(a) rejection of claims 17 and 33.

It has been very well established that to establish a *prima facie* case of obviousness (e.g. a proper § 103(a) rejection) three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all the claim limitations. (See, M.P.E.P. § 2143). The Examiner has not met any of the three basic requirements of a proper § 103(a) rejection of claims 17 and 33. Furthermore, the Examiner “bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” If the Examiner does not produce a *prima facie* case, “the applicant is under no obligation to submit evidence of nonobviousness.” (see, M.P.E.P. § 2142).

Applicants also note that deficiencies of Czerwinski in regard to independent claims 17 and 33 are discussed in Applicants' previously filed Appeal Brief from which the Examiner reopened prosecution with the current rejection. For the reasons stated above in regard to Adams and the reasons stated in the previous Appeal Brief in regard to Czerwinski, it is clear that neither Adams nor Czerwinski, alone or in combination, teaches or suggests all the limitations of independent claims 17 and 33.

Thus, for at least the reasons presented above, the rejection of independent claims 17 and 33 is not supported by the cited art and removal thereof is respectfully requested.

Applicants also assert that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the rejection has been shown to be unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time.

Allowable Subject Matter:

Claims 8, 24 and 40 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. Applicants submit that claims 8, 24 and 40 are allowable in their current form.

CONCLUSION

Applicants submit the application is in condition for allowance, and prompt notice to that effect is respectfully requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5181-70400/RCK.

Also enclosed herewith are the following items:

- Return Receipt Postcard
- Petition for Extension of Time
- Notice of Change of Address
- Other:

Respectfully submitted,



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